

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on January 14, 2004. In response there to, claims 1, 4, 5 and 21 are amended, as a result, claims 1-10, 20 and 21 are now pending in this application. The amendments to the claims are to clarify the subject matter that applicants regard as their invention. No new subject matter is added. The amendments do not narrow the scope of protection afforded. Thus, the Amendments do not create estoppel which would limit the claims. Accordingly, Applicant is entitled to a full range of equivalents upon issuance of the instant claims.

Information Disclosure Statement

Applicants again respectfully request that a copy of the 1449 Form, listing all documents that were submitted with the Supplemental Information Disclosure Statement filed on October 16, 2000, marked as being considered and initialed by the Examiner, be returned with the next official communication. This Supplemental Information Disclosure Statement was originally submitted in October of 2000 and resubmitted along with all 96 non-US Patent documents in July of 2002 as part of the COMMUNICATION REGARDING RECONSTRUCTION OF PATENT OFFICE APPLICATION FILE SN 09/313,048, filed in response to the Notice Under 37 C.F.R. § 1.251 from the USPTO, dated April 11, 2002.

Examiner Interview Summary

Applicants thank Examiner Berch for his courtesy during the telephone interview with Applicants' attorney William F. Prout, on March 26, 2004. The formal objections to claims 1, 4, and 5 were discussed. In particular, agreement was reached as to the language for these claims. The amendments to the claims are reflected in amended claims 1, 4, and 5, presented hereinabove.

In addition, claim 21 and the support for the compound claimed was discussed in the specification was discussed. The Examiner advised that the specification was filed having a discrepancy and requested clarification. Agreement as to allowability of rejected claims 1-5 and 8-10 was reached.

The above account is believed to be a complete and accurate summary of the telephonic interview as required by 37 C.F.R. §1.133. If the Examiner believes that this summary is inaccurate or incomplete, Applicant respectfully requests that the Examiner point out any deficiencies in her next communication so that Applicant can amend or supplement the interview summary.

§112 Rejections of the Claims

Claims 1-5 and 8-10 were rejected under 35 USC § 112, first paragraph, as allegedly failing to comply with the written description requirement. The examiner objected to the phrase “amino acid residue” as broader than the original claim language. Claims 1, 4 and 5 are amended in accordance with the Examiner’s Interview Summary discussed above. Accordingly, it is respectfully requested that the rejection under 35 USC § 112, first paragraph, be withdrawn..

Claims 1-5 and 8-10 were rejected under 35 USC § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In this Office Action and the prior Office Action the examiner objected the terms “residue” and “ester of an amino acid” in claims 1 and 4. To the extent that this rejection may be maintained with respect to the pending claims, it is respectfully traversed.

The claims have been clarified as discussed in the interview. The claim is amended to read “an amino acid residue formed by the removal of a hydrogen atom from the -COOH group of an amino acid.” It is respectfully submitted that the language in the claims is proper.

The Examiner objected to claim 21 as unsupported by the specification. The Examiner advised that the specification was filed having a discrepancy and requested clarification. This claim has been amended to recite the correct compound.

Applicants note the specification was amended, in the amendment mailed December 2, 1999, to recite “At page 11, structure 8b, delete “(R=Et)” and insert “--(R=Pr)--.” This amendment is supported by the specification at page 9, where compound 1b recites that R is n-C₃H₇. In addition, also at page 9, compound 6 also recites that the R group is propyl. Thus, it

is respectfully submitted that the term “propyl” at page 11 is correct and the amendment represents a minor typographical error. Accordingly, claim 21 has been amended to recite the propyl compound.

In view of the amendments and remarks herein it is respectfully requested that the objections under 35 USC § 112 be withdrawn.

Claim Objections

Claim 21 was mislabeled as Claim 1. Applicant has renumbered the claim properly as Claim 21.

Allowable Subject Matter

Claims 6, 7 and 20 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants submit that, in view of the amendments and remarks herein that the objections under 35 U.S.C. §112 are overcome and that all claims are in condition for allowance. Thus, it is respectfully requested that the claims pass to issue.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6968 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date April 14, 2004

By William F. Prout
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 14th day of April, 2004.

Dawn M Poole

Name

Dawn M Poole

Signature